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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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Application Number

10/619,413

Filed

July 16, 2003

First Named Inventor

DORON HANDELMAN

Art Unit

2874

Examiner

Juliana K. KANG

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☒ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐ attorney or agent of record.
Registration number _____

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5-FEBRUARY 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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**ARGUMENTS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR
REVIEW**

Applicant respectfully requests review of the grounds of rejection of the claims pending in the present application.

5 The status of the claims pending in the present application is as follows: claims 1 – 14, 26 – 31 and 37 – 52 stand rejected under 35 USC 103(a) as being unpatentable over Published US Patent Application US 2002/0118441 of Kang et al (Kang) and further in view of US Patent 6,636,337 to Johnson et al (Johnson).

10 The review of the grounds of rejection is requested in view of the following arguments:

Arguments with respect to claims 1, 26 and 37

(1) The Examiner failed to establish a *prima facie* case of obviousness because the limitation of the first subset of the set of nonlinear elements which is
15 configured to function as a set of ON/OFF switches in the “OFF” state is not met by any of the Kang and Johnson references (see, e.g., the arguments from line 23 on page 2 through line 15 on page 3 in the Response filed 1 September 2005). Note that the Examiner acknowledges that Kang does not specifically teach first and second subsets of nonlinear elements (see, e.g., the last line on page 2 and the first
20 line on page 3 in the Official Action dated 11 August 2005, and the paragraph bridging pages 2 and 3 in the Final Official Action dated 16 November 2005). Johnson also does not show or suggest the first subset of the set of nonlinear elements which is configured to function as a set of ON/OFF switches in the “OFF” state as is clearly evident from Johnson.

25 (2) The Examiner failed to establish a *prima facie* case of obviousness because the Examiner failed to show proper motivation to combine or modify Kang and Johnson. The motivation suggested by the Examiner in lines 7 – 10 on page 3 in the Official Action dated 11 August 2005 and repeated in lines 4 – 7 on page 3 in the Final Official Action dated 16 November 2005 does not refer to the nature of the
30 problem to be solved, does not suggest the desirability of the claimed invention, and is irrelevant to claims 1, 26 and 37.

(3) Further with respect to the criterion of motivation to combine or modify Kang and Johnson, the Examiner did not suggest any way of combining or modifying the Kang and Johnson references other than using the Kang logic unit in Johnson (see, e.g., lines 7 – 10 on page 3 in the Official Action dated 11 August 2005, and lines 4 – 7 on page 3 in the Final Official Action dated 16 November 2005). Usage of the Kang logic unit in Johnson does not produce the claimed invention (see, e.g., the arguments in the second full paragraph on page 3 in the Response filed 1 September 2005) and therefore a proposed combination or modification based on usage of the Kang logic unit in Johnson teaches away from claims 1, 26 and 37. Accordingly, there can be no suggestion and no motivation to make the proposed combination or modification.

(4) The Examiner failed to establish a *prima facie* case of obviousness because the Examiner failed to show that the Kang and Johnson references teach or suggest all the claim limitations. Specifically, the combined teachings of Kang and Johnson would have not and could have not suggested the combinations of any of claims 1, 26 and 37 to those of ordinary skill in the art and there is no apparent modification to the Kang and Johnson references that can be made and which can produce the claimed invention without changing the principle of operation of at least one of Kang and Johnson or rendering at least one of Kang and Johnson inoperable (see, e.g., the arguments in the Response filed 10 January 2006 from the third full paragraph on page 3 through the second full paragraph on page 5). Also, the Examiner did not particularly show (see, e.g., the Examiner's arguments in lines 14 – 17 on page 4 in the Final Official Action dated 16 November 2005) how can a plurality of sets of nonlinear elements in a combination of Kang with Johnson be configured to do any optical processing including OFF state of one set of nonlinear elements enabling another set of nonlinear elements to be configured to perform optical processing, and Applicant believes that there is no apparent way in which a combination of Kang and Johnson can be configured to produce such a result without changing the principle of operation of at least one of Kang and Johnson or rendering at least one of Kang and Johnson inoperable. Accordingly, the teachings of the Kang and Johnson references are not sufficient to render the claims *prima*

facie obvious.

Additional arguments which apply to claim 7

(5) Kang does not show or suggest two output signals and a combination of Kang with Johnson does not show or suggest the combination of claim 7 (see, e.g., the arguments in lines 4 – 10 on page 4 in the Response filed 1 September 2005). The teachings of the Kang and Johnson references are therefore not sufficient to render claim 7 *prima facie* obvious.

Arguments with respect to claims 12 and 30

(6) The arguments submitted above for claims 1, 26 and 37 also apply to claims 12 and 30.

(7) The combinations recited in claims 12 and 30 are neither shown nor suggested in the Kang and Johnson references (see, e.g., the arguments in lines 12 – 27 on page 4 in the Response filed 1 September 2005).

Favorable consideration of the Pre-Appeal Brief Request for Review and allowance of the present application are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, consisting of a series of loops and a horizontal line, positioned above the printed name.

Doron HANDELMAN

Date: February 5, 2006